

REMARKS

The Examiner rejected claims 2, 9, 13-15, 17-21 and 40-49 “under 35 U.S.C. 102(a) as being anticipated by Acharya et al. (Proc. Of 6th Int. Sym. Mag. Mat., Proc. and Dev., Phoenix, Oct. 2000) as evidenced by Tam et al. (U.S. Patent No. 5,412,809).”

Office Action, page 4. The Office Action states:

With regard to the limitations regarding the time to reach steady state of the lower magnetic layer upon termination of the application of a write magnetic field... it has been held that where the claimed and prior art products are identical or substantially identical in structure or composition ... a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency....

Office Action, page 5. Applicants submit herewith a declaration by Dr. Gerardo Bertero demonstrating that Acharya’s disclosed structure does not inherently include the limitation mentioned by the Examiner. See ¶¶2-8. Accordingly, Applicants have met their burden, and the rejection of these claims should be withdrawn.

The Examiner rejected claims 3-8 as obvious. These claims depend, either directly or indirectly, on claim 13, and hence are patentable for at least the reasons as claim 13.

The Examiner rejected claims 22-26. Applicants have amended claim 22 so that these claims now depend either directly or indirectly on claim 19. Therefore, claims 22-26 are patentable for at least the same reason as claim 19.

The Examiner rejected claims 27-37 “as being unpatentable over Acharya et al. as evidenced by Tam et al. as applied above, and further in view of Richter et al. (IEEE Trans. Mag. 34(4), 1998, 1540-1542) and Richter et al. (IEEE Trans. Mag., 37(4) 2001,

1441-1444)." Office Action, page 9. Applicants traverse this rejection. This rejection hinges on the assumption that Richter and/or Acharya teach something that would make it desirable to reduce the dynamic coercivity of a lower magnetic layer. For reasons set forth in Bertero Declaration ¶¶14-20, this assumption is incorrect. Therefore, these claims should be allowed.

The Examiner rejected claims 38 and 39 as "unpatentable over Acharya et al. as evidenced by Tam et al. as applied above, and further in view of Igarashi et al. ('140 A1) and Carey et al. (U.S. Patent App. No. 2003/0022023 A1)." Office Action, page 11.

This rejection hinges on the assumption that Igarashi teaches magnetically soft materials. For reasons set forth in Bertero Declaration ¶9-11, this assumption is incorrect. Therefore, this declaration should be withdrawn.

As claims 2-9, 13-15, 17-21 and 27-49 distinguish over the cited art, Applicants respectfully submit that the application is in condition for allowance. If the Examiner's next action is other than allowance, the Examiner is respectfully requested to telephone Applicants' attorney at (408) 732-9500 for a telephone interview.

Respectfully Submitted,

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